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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 222

JOHN M. SISKO,
Petitioner,

v.

SOUTHERN RESIN &
FIBERGLASS CORPORATION,
Respondent.

REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER

Respondent's Brief, filed July 6, 1967, challenges the primary basis for this Petition, arguing that the courts below had correctly applied the doctrines laid down by this Court in the *Graham* and *Adams* cases.[1] Petitioner submits that this position is predicated upon a completely erroneous interpretation of *Graham* and *Adams*, and upon an incomplete and misleading presentation of the facts under consideration here. Accordingly, this Brief is submitted under the provisions of Rule 24(4).

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[1] *Graham v. John Deere, Co.*, 383 U.S. 1, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966); *United States v. Adams*, 383 U.S. 39, 15 L. ed. 2d 572, 86 S. Ct. 708 (1966).

Sisko Invention Is Closely Comparable to Adams Invention

Respondent alleges (Respondent's Brief, p. 5) that the Petition only asserts an argument of the facts in this case. And yet *Graham* and *Adams* demand this type of factual inquiry in applying the test of obviousness. Indeed the factual parallels between the Adams invention and the Sisko invention are so striking that they virtually preclude a holding of obviousness here.

Adams made the first successful water-activated, constant potential battery which could be stored indefinitely without fluid (L. ed. 2d 575). It was an important invention, recognized and adopted by the industry (L. ed. 2d 576). Similarly, Sisko made the first *unitary flexible core material for fiberglass laminates*, the first core material which would drape to adapt itself to compound curves. This was also important, recognized and adopted. Even the infringer, referring to its own infringing copy, called it "the most single greatest advancement in structural core materials in the last decade" (PX 140).

Sisko, like Adams, was an independent inventor who had worked with his own facilities for a period of years before he finally conceived his invention (383 U.S. 43). In both cases the inventors had found success only after long experimentation had finally led them to a solution, and in both cases the solution lay in a direction away from the prior art teachings (383 U.S. 45). Just as the Scrivanoff prior art in *Adams* had been a failure (383 U.S. 48), so too had the closest prior art (by Nortex and Edwards) in the fiberglass core field been a failure; and just as the Patent Office Examiner handling the Adams application had been unable to cite a single reference against the case (383 U.S. 52) so too the Examiner handling the Sisko application had failed to cite a single reference drawn from the field of flexible core materials.

As in *Adams* (383 U.S. 42), Sisko's invention was a simple but novel combination of three elements, all of which

were acknowledged to be old in and of themselves. But, as in *Adams* (383 U.S. 51), the Sisko invention performed a result that had never before been accomplished. There, as here, the key to success was "an interdependent functional relationship" of these elements (383 U.S. 50), and in both instances this was the basis upon which patentability was predicated.

Interestingly enough, in *Adams*, as here, an infringer with far greater resources, experience and expertise had been unable to come up with the solution which the industry had been seeking. There, as here, no alternative solution was found, and the infringer then proceeded in total disregard of the patentee's rights (383 U.S. 44).

In view of the foregoing, there is no basis for the Respondent to summarily dismiss (Respondent's Brief, p. 5) the Petitioner's contention that the *Adams* doctrine was not properly applied below.

Sisko's Invention Is Different in Kind From Graham and Calmar Inventions

Both patents which were invalidated by this Court in the *Graham* case related to minor improvements in devices that were old in the art, devices that had already been in use for the same purposes.

Graham had already received his '811 patent on a workable plow that had been put into use. In the '798 patent in suit, two minor mechanical changes had been made, with only marginal improvements in result or function being claimed. Even the petitioner's expert had minimized the effect of these changes (383 U.S. 24, Footnote 12).

Similarly in *Calmar*, the alleged invention was simply a case of putting a rib seal in a different position and preventing the overcap from contacting the container cap. No significant change in function resulted, i.e., the patented construction operated in the same general manner for the same general purposes as the prior art.

Thus, neither of these cases involves a situation like *Adams* or *Sisko* wherein the overall combination is new and wherein for the first time this combination achieves a result never before obtainable.

The Sisko Invention Meets the Tests Expounded in Graham

On the other hand, the *Graham* case specifically spells out the criteria of patentability upon which the Petitioner is relying in the present case. There the Court cited the importance of the basic factual inquiries into the scope and content of the prior art, the distinctions of the claimed invention, and the level of ordinary skill in the field. Here we have clear distinctions over the prior art, dramatic differences in result, and demonstrated facts as to the difficulties in achievement by the inventor and others in the field. Indeed, on the critical last point, it has been shown that the infringer had serious problems in copying the product even *after* he saw the patented product and knew how successful it was (PX 81-83). How then was this solution obvious?

In *Graham* the Court went on to specifically espouse an inquiry into such further factors as "commercial success, long felt but unsolved needs, failure of others, etc.". (383 U.S. 17) All of these factors have been abundantly demonstrated by the evidence in the present case, but their significance was ignored by the Court below.

The Need for Further Guidance Explained

Petitioner has argued (Petition, page 12) that the doctrine of obviousness requires further elucidation by this Court, and Respondent leaps to the conclusion (Respondent's Brief, page 5) that this argument implies some inadequacy in the *Graham* and *Adams* opinions. If this type of reasoning were followed, exception would have to be taken every Sunday with all sermons given on the Ten Commandments; but there, as here, no criticism of the draftsmanship is intended.

On the contrary, this Court's opinions in *Graham* and *Adams* were most clearly and thoughtfully expounded, and the issue of obviousness was treated in some depth. Nevertheless, the issue is of paramount importance to the patent law, and the Court should insure against any disregard or misinterpretation of the guidelines it has laid down. The facts of the pending case are clearcut. They lend themselves well to the type of factual inquiry which the Court has espoused, and they lead preponderantly to a holding contrary to that of the Court of Appeals below. Thus they provide an excellent opportunity to underscore and amplify the Court's philosophy on obviousness. This would be of great benefit to the courts below, to the patent profession, and to the patent system generally.

The *Graham* and *Adams* cases have been cited extensively in subsequent decisions, and the need for further guidance is clearly apparent from the many and varied interpretations that have resulted. One of the primary rules of law emphasized by this Court in *Graham* was the necessity of pursuing factual inquiries of the type here under consideration *before* determining the question of obviousness (383 U.S. 17) The Court stressed that the invention must be considered with reference to its position in the art and with reference to its functional and commercial impact. This emphasis could have had but one purpose: to deter the often acknowledged but still abused practice of simply making an unsupported subjective decision as to what is obvious and what is not. This very natural tendency has been the cause of conflicting standards of patentability as applied by the Patent Office and the various courts prior to *Graham*. The hazards involved in making such a purely subjective decision had been cited by Judge Learned Hand as follows:

> "To judge on our own that this or that new assemblage of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it." (*Reiner v. I. Leon Co.*, 285 F.2d 501 (C.A. 2, 1960)

Without such factual inquiry, the courts have been particularly prone to judge by hindsight and to unintentionally convert "simplicity into obviousness in the face of hard proof of recognized need for the answer, of long, unsuccessful search for the answer by people of skill in the art, of recognition by the industry that the claimed invention was the answer, and of its prompt adoption with attendant commercial success." *Allen v. Standard Crankshaft & Hydraulic Co.*, 323 F.2d 29 (C.A. 4, 1963)

There has been a disturbing tendency since the *Graham* decision for courts to recite the factual inquiries and then to ignore them completely in coming to a purely subjective decision, still citing *Graham* as authority. See, for example, the dissenting comments in *Application of Dailey*, 357 F.2d 669, 673-679 (CCPA, 1966). After a careful appraisal of relevant facts not properly understood by the majority, Judge Smith concluded:

> "While the majority has seen fit to pay lip service to the decision in Graham v. John Deere Co. of Kansas City, 86 S. Ct. 684, it is my opinion that it has ignored the fundamental rationale of the case which, as I view it, would prohibit the type of obviousness rejection which the majority here affirms." p. 677.

See also a similar dissent in the Fifth Circuit in the case of *Upright Inc. v. Safway Products, Inc.*, 364 F.2d 580 (C.A. 5, 1966), where Judge Marvin Jones concluded at p. 584:

> "The majority of this court, and the court below, although professing to be guided by the factual inquiries specified in Graham, in my judgment misapply these tests and thereby reach an erroneous legal conclusion."

In the following cases, each of which rely upon *Graham* for support, the results raise a serious question as to whether the respective courts have properly evaluated the effect of the *Graham* decision:

> *L and A Products, Inc. v. Britt Tech Corporation*, 365 F.2d 83 (C.A. 8, 1966); *Santa Anita Manufac-*

turing Corp. v. Lugash, 369 F.2d 964 (C.A. 9, 1966); and *Davis v. Mathews*, 361 F.2d 899 (C.A. 8, 1966).

In the latter case, for example, none of the prior art was held to resemble the invention or to anticipate any of its basic features. The invention apparently functioned in a novel manner and was a commercial success, and yet, in spite of extensive reference to the *Graham* decision, it would appear that the Court ignored all such relevant factual considerations and decided on the basis of its own personal subjective opinion of obviousness. This is the very type of reasoning which should have been precluded by this Court's ruling in the *Graham* case.

Critical Errors and Deficiencies in Respondent's Statement

There would be no possibility of accepting Respondent's substantive conclusions unless this Court were to make the drastic mistake of accepting at face value the Respondent's statement of the case. This abbreviated presentation is so incomplete, selective and inaccurate that it is entirely misleading.

Petitioner recognizes how easy it would be to start with the relatively simple nature of the invention, to then realize how plausible Respondent's presentation sounds, and then to accept the holding of obviousness below. For this reason Petitioner feels that the basic facts must be subjected to a more searching scrutiny than is normally necessitated in proceedings before this Court, and such enquiry is most earnestly solicited.

Addressing directly the Respondent's presentation, it is submitted that the prior art practices of Nortex and Edwards are misrepresented. At page 3 of the Brief, Respondent speaks of wood "blocks" which were "held together by" a backing cloth glued across one surface of the blocks. This description, as far as it goes, would appear to be a complete anticipation of the patented construction. What the description fails to acknowledge is that the "blocks" of Nortex and

Edwards were not truly held together by the backing sheet. On the contrary, the entire assembly was coated with a thick layer of resin which was allowed to harden in assembly stage. Thus, it was the resin itself, and *not* the backing sheet, which really held the elements together. More important, this resin made the completed assembly as stiff as a board, whereas the very purpose of the Petitioner's invention was to achieve a flexible core material.

The foregoing interpretation of the prior art is not mere speculation. It is clearly illustrated by the photograph PX-77 and is unequivocally established by the testimony of Jordan Pfuntner (R. 271-277) which stands undisputed and unrebutted in the record. If contrary proof were available, the infringer would have had it because the infringer had supplied both Nortex and Edwards. Against this record it is entirely misleading for the Respondent to remain silent on this very basic distinction over the prior art.

It should be noted that the Respondent merely acknowledges that the Petitioner uses smaller blocks than the prior art. In actual fact, the record clearly shows that the prior art constructions of Nortex and Edwards involved elongated slats rather than square blocks, and that these slats were arranged in a longitudinally staggered brick-type pattern rather than being in aligned, side-to-side, and end-to-end relationship (R. 271). This configuration and disposition of the prior art elements would in itself have precluded any significant flexing of the assembly. Thus, the prior art, even if it had not had a rigid resin coating, could not have adapted itself to compound curvatures of the type with which the Petitioner was concerned.

In trying to suggest that Edwards and Nortex might have been completely satisfied with their product, Respondent fails to acknowledge the evidence establishing that this was an unsatisfactory product (R. 271, 280). As to whether Edwards and Nortex were themselves satisfied, Petitioner would only note that both of them were quickly out of business (R. 166, 279).

In referring to the patented prior art, Respondent fails to acknowledge that Ams and Cunninghame contain no teachings that were not already of record in the prior patents cited by the Patent Office. Respondent also fails to acknowledge that these patents were drawn from the entirely non-analogous art of decorative wall coverings or the like. There is no suggestion in Respondent's presentation as to why a man skilled in the art of laminated core materials would look to the field of decorative wall coverings for guidance, and there is no indication of why he would take the further step of effecting the modifications necessary to adapt the Cunninghame and Ams constructions to this new use. The conclusion of obviousness is strictly a matter of hindsight and this is clearly demonstrated by the facts: by the inventor's long and arduous development work, by the failure of the infringer's previous efforts to develop a satisfactory product of this type, and by the frantic and unsuccessful efforts of the infringer to develop a competing product that did not infringe. These facts are all clearly of record and must be recognized before the invention can be viewed in the proper context.

Finally, Petitioner would note that the issue of public use, referred to on page four of Respondent's Brief, is not in issue here.

SUMMARY

For the foregoing reasons, Petitioner renews his application for this Honorable Court to grant certiorari in this matter.

Respectfully submitted,

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